

Appl. No. 10/669,848

Reply to Examiner's Action dated November 15, 2005

REMARKS/ARGUMENTS

The Applicants have carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicants originally submitted Claims 1-21 in the application. The Applicants have amended Claims 1 and 11 and have canceled Claims 4 and 14. The Applicants have not added any claims. Accordingly, Claims 1-3, 5-13 and 15-21 are currently pending in the application.

I. Rejection of Claims 1, 2, 4-8, 11, 12, 14-18 and 21 under 35 U.S.C. §102

The Examiner has rejected Claims 1, 2, 4-8, 11, 12, 14-18 and 21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,512,919 to Ogasawara. As the Examiner is no doubt aware, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference; the disclosed elements must either be disclosed expressly or inherently and must be arranged as in the rejected claims.

Ogasawara does not anticipate the present invention because Ogasawara does not disclose coded data being decoded in a mobile phone. Ogasawara discloses an electronic shopping system that facilitates purchase transactions via a wireless videophone. The purchase transaction program is downloaded from the seller's server to the purchaser's wireless videophone via a program loader contained within the purchaser's wireless videophone. The purchase transaction program is stored in a program memory and is used by the purchaser to facilitate the selection of items to be purchased, as well as payment therefor. A digital camera is attached to the wireless telephone to facilitate the

Appl. No. 10/669,848

Reply to Examiner's Action dated November 15, 2005

selection of items to be purchased and is controlled via the downloaded purchase transaction program to function as a bar code or product icon image capture device. Character or pattern recognition software translates the bar or icon code image into an appropriate item identifier. (Abstract). However, the decoding of the coded information appears to solely take place within the seller's server. See column 6, lines 46-50, where it is stated that the store server or remote server receives the bar code data, searches a database and obtains a description and price for the item. See also, column 7, lines 34-40, where it is noted that bar code data and not decoded data is sent to the server.

The Examiner points to language in column 12, lines 25-26, and column 18, lines 17-19, as evidence that the device described in Ogawawara decodes data in a mobile telephone. The Applicants respectfully note that the description in column 12, lines 25-26, refers to a "purchase transaction program" being downloaded from a server, without describing what all may be included in such program. The purchase transaction program can mean a number of different things, but most likely refers to steps necessary to integrate the telephone with the specific merchant server. (Col. 12, lines 36-41). In column 18, lines 17-19, Ogasawara the passage refers to a tailored purchase transaction program that might include character recognition and/or pattern recognition as well bar code decode, software without specifying where the decoding is taking place. Thus, Ogasawara does not disclose each and every element of the claimed invention.

Inasmuch as Ogasawara does not disclose each and every element of the claimed invention and, as such, is not an anticipating reference with respect to independent Claims 1, 11 and 21, and because Claims 2, 5-8, 12 and 15-18 are each respectively dependent upon either Claim 1 or Claim

Appl. No. 10/669,848

Reply to Examiner's Action dated November 15, 2005

11, Ogasawara also cannot be an anticipating reference for Claims 2, 5-8, 12, 15-18. Accordingly, the Applicants respectfully request the Examiner to withdraw the §102 rejection with respect to these Claims.

II. Rejection of Claims 3 and 13 under 35 U.S.C. §103

The Examiner has rejected Claims 3 and 13 under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of U.S. Patent Application No. 20020102966 by Lev, *et al.* (Lev)... As the Examiner is no doubt aware, determination of obviousness requires consideration of the invention considered as a whole; the inquiry is not whether each element exists in the prior art, but whether the prior art made obvious the invention as a whole. Furthermore, there must be some suggestion or teaching in the art that would motivate one of ordinary skill in the art to arrive at the claimed invention; a reference that teaches away from a claimed invention strongly indicates nonobviousness. Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

As indicated above, Ogasawara does not disclose coded data being decoded in a mobile phone. Inasmuch as Lev does not overcome this shortcoming of Ogasawara with respect to

Appl. No. 10/669,848
Reply to Examiner's Action dated November 15, 2005

independent Claims 1 and 11 on which Claims 3 and 13 depend, Ogasawara, individually or in combination with Lev, fails to teach or suggest the invention recited in independent Claims 11 and 11. Thus, dependent Claims 3 and 13, when considered as a whole, are not obvious in view of Ogasawara in view of Lev.

In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 3 and 13 under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner withdraw the rejection.

III. Rejection of Claims 9 and 19 under 35 U.S.C. §103

The Examiner has rejected Claims 9 and 19 under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of U.S. Patent Application No. 20050017453 by Rehbein, *et al.* (Rehbien). As previously indicated, Ogasawara does not disclose coded data being decoded in a mobile phone. Inasmuch as Rehbein does not overcome this shortcoming with respect to independent Claims 1 and 11 on which Claims 9 and 19 depend, Ogasawara, individually or in combination with Rehbein, fails to teach or suggest the invention recited in independent Claims 11 and 11. Thus, dependent Claims 9 and 19, when considered as a whole, are not obvious in view of Ogasawara in view of Rehbien.

In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 9 and 19 under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner withdraw the rejection.

Appl. No. 10/669,848

Reply to Examiner's Action dated November 15, 2005

IV. Rejection of Claims 10 and 20 under 35 U.S.C. §103

The Examiner has rejected Claims 10 and 20 under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of U.S. Patent Application No. 20050040230 by Swartz, *et al.* (Swartz), and further in view of Lev. Again, as noted above, Ogasawara does not disclose coded data being decoded in a mobile phone. Inasmuch as neither Swartz nor Lev overcomes this shortcoming of Ogasawara with respect to independent Claims 1 and 11 on which Claims 10 and 20 depend, Ogasawara, individually or in combination with Lev and Swartz, fails to teach or suggest the invention recited in independent Claims 11 and 11. Thus, dependent Claims 10 and 20, when considered as a whole, are not obvious in view of Ogasawara in view of Lev and further in view of Swartz.

In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 10 and 20 under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner to withdraw the rejection.

IV. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-3, 5-13, and 15-21.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The

FEB. 13. 2006 2:49PM

HITT GAINES 9724808865

NO. 3818 P. 13

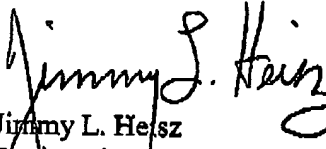
Appl. No. 10/669,848

Reply to Examiner's Action dated November 15, 2005

Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account
08-2395.

Respectfully submitted,

HITT GAINES, PC


Jimmy L. Heisz
Registration No. 38,914

Dated: Feb 13, 2006

P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800